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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,703	04/26/2001	Hermann Lubbert	STERN 1.001APC	1875
20995	7590	03/09/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			QIAN, CELINE X	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/830,703

Applicant(s)

LUBBERT, HERMANN

Examiner

Celine X Qian

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 8, 14, 15, 22, 33, 34 and 36-38.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Anne-Marie Falk

ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER

Continuation of 2. NOTE: The proposed amendment introduces new limitations to the claim (for example, wherein said homolog has an amino acid sequence at least 70% identical to said mutant parkin2 protein) that would require a new search. Therefore, the amendment will not be entered.

Continuation of 5. does NOT place the application in condition for allowance because: the proposed amendment does not overcome the 112 1st rejection (both written description and enablement) for same reasons set forth of the record mailed on 1/28/03 and 11/20/03. Applicant provides 12 references and assert that these references teach that the phenotype of one transgenic species is predictable of the same phenotype of another species, for example, from human to mouse. These references have been reviewed, however, they do not support Applicant's assertion. First, none of the references teaches a transgene in human. Second, the generation of the mouse models of human diseases are result from extensive research practice rather than routine experimentation. For reasons discussed in the previous actions, the art teaches that the phenotype of a transgenic mouse is unpredictable. The specification does not teach any methods to overcome such unpredictability. Therefore, one skilled in the art would have to engage in undue experimentation to make/use the claimed invention.

Applicant also argues that transgenic rat can be generated by using embryonic stem cells because of the teaching of two patents (US6156952 and 6372956). This argument is unpersuasive. Contrary to Applicant's assertion, neither patents enables a method of making transgenic rats using rat embryonic stem cells. As discussed in the previous office actions, rat ES cells are not available at the time the application is filed. Therefore, the enablement rejection is maintained.

The proposed amendment also fails to overcome the written description requirement. The claimed genus of a homologue of mutant parkin2 that share 70% sequence homology to said mutant parkin2 encompasses a large number of polypeptides that have sequence homology with parkin2. However, the specification does not teach what type of mutation in the sequence of mutant parkin2 is necessary for its function. As such, the structural functional relationship is missing. And the written description requirement is not met. The amendment to claim 14 would overcomes the 112 2nd rejection if entered.